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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,225

12/05/2005

Jarmo Smahl

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EXAMINER

KEE, FANNIE C

ART UNIT

PAPER NUMBER

3679

NOTIFICATION DATE

DELIVERY MODE

06/23/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

INFO@ORTPATENT.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/530,225	<b>Applicant(s)</b> SMAHL, JARMO	
	<b>Examiner</b> Fannie Kee	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9,11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/29/09 has been entered.

### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities: add the word --the-- between the words “such that” and “two straight portions” in line 15 and add the word --being-- before the word “formed” in line 19.

Correction is required.

3. Claim 4 is objected to because of the following informalities: add the word --being-- before the word “aligned” in line 3.

Correction is required.

4. Claim 6 is objected to because of the following informalities: add the word --the-- between the words “such that” and “two straight portions” in line 14 and add the word --being-- before the word “formed” in line 18.

Correction is required.

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5. Claim 11 is objected to because of the following informalities: add the word --the-- between the words "such that" and "two straight portions" in line 14 and add the word --being-- before the word "formed" in line 17.

Correction is required.

6. Claim 12 is objected to because of the following informalities: add the word --the-- between the words "such that" and "two straight portions" in line 13 and add the word --being-- before the word "formed" in line 17.

Correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 2, 4, 5, 9, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 11, the phrase "and/or" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and/or"), thereby rendering the scope of the claim(s) unascertainable.

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Claim 4 recites "A connecting piece according to claim 3". Claim 4 cannot depend from claim 3 because claim 3 is a cancelled claim. It is assumed that claim 4 depends from claim 1 as claim 3 originally depended from claim 1 and the claims will be treated in this manner.

Claims 5 and 9 recite the limitation "the portion which is arranged smooth". There is no antecedent basis for these claims as the portion which is arranged smooth is a structure which has not been positively recited. As it is not clear what Applicant is referring to, Examiner will interpret this limitation as best understood within the context of the claims.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Mazzacano et al EPO Patent No. EP 0 870 970 A2.

With regard to claim 1, and as seen in Figure 2 below, Mazzacano et al disclose a connecting piece, intended for connecting at least two elements, a first element connected to a first end of the connecting piece and a second element connected to a second end of the connecting piece, the connecting piece comprising:

a body mainly of plastic (102);

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a metal insert (107) positioned at at least one end of the connecting piece, the metal insert provided with a thread (108), the metal insert configured such that at least one of the first and second elements can be connected to the connecting piece by a threaded connection; and

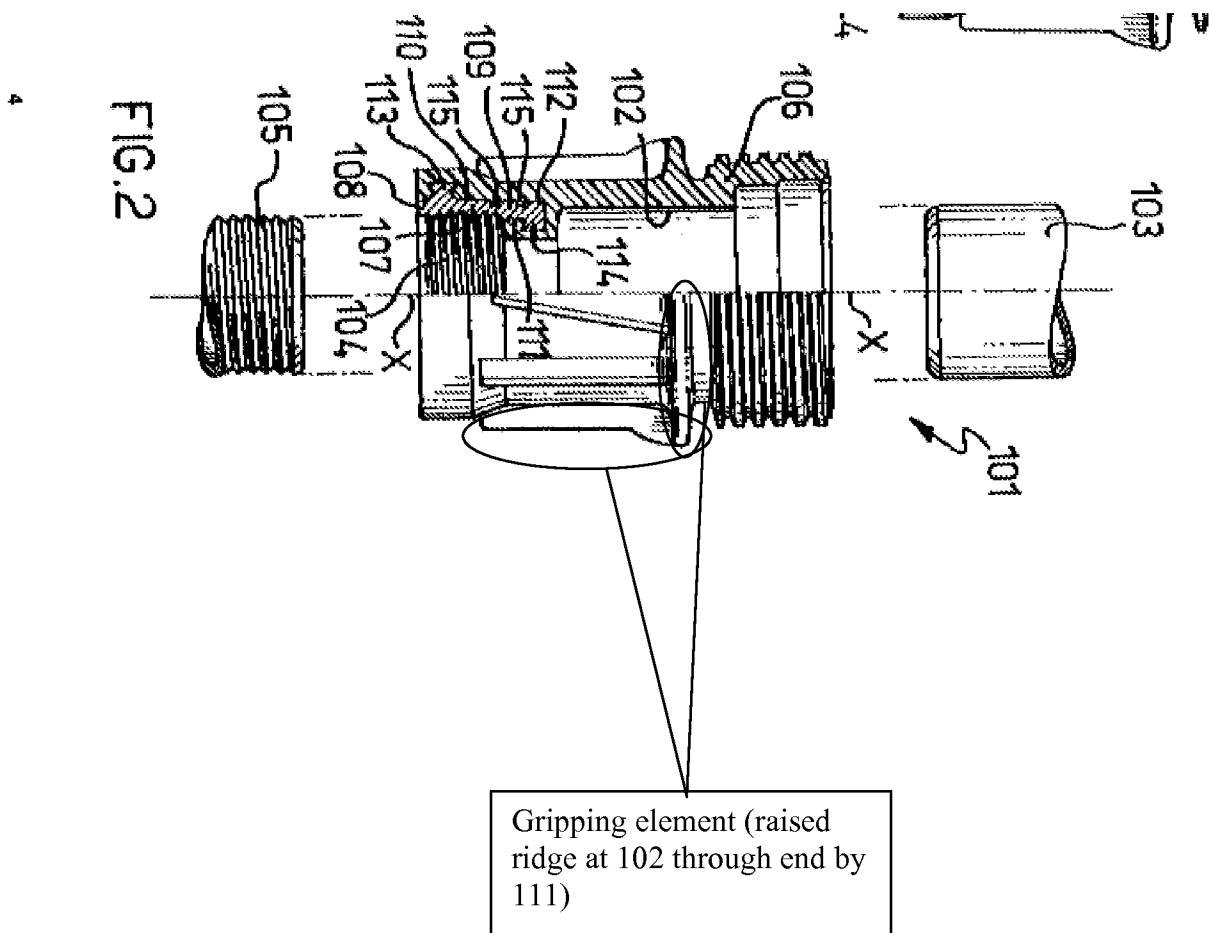
at least one gripping element disposed around the outer surface of the connecting piece manipulatable for allowing either the connecting piece to rotate relative to at least one of the first and second elements or at least one of the first and second elements to rotate relative to the connecting piece while making a threaded connection, the gripping element comprising:

at least two straight portions (straight portions are ribs disclosed circumferentially around the connecting piece - next to 111) arranged such that two straight portions on opposite sides of the connecting piece are parallel, the straight portions forming gripping surfaces for a tool;

the gripping element formed of two or more ribs (ribs disposed – next to 111) disposed circumferentially around the connecting piece;

whereby the gripping element is formed such that a tool surrounding the gripping element slips before the thread and/or the basic structure of the connecting piece gets damaged.

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With regard to claim 2, and as seen in Figure 2, Mazzacano et al disclose the gripping element comprising six straight portions.

With regard to claim 4, and as seen in Figure 2, Mazzacano et al disclose the outer surface of the metal insert being provided with ribs (113) extending outward from the metal insert, the ribs of the metal insert aligned with the ribs of the gripping element (aligned axially).

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With regard to claim 5, and as best understood by Examiner, Mazzacano et al disclose the portion which is arranged smooth being a rounded portion.

11. Claims 6, 7, 9, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hattori et al U.S. Patent No. 6,050,608.

With regard to claim 6, and as seen in Figure 1, Hattori et al disclose a connecting piece, intended for connecting at least two elements, a first element connected to a first end of the connecting piece and a second element connected to a second end of the connecting piece, the connecting piece comprising:

- a body (body of 1) mainly of thermoplast (column 3, lines 52-55);

- a thread (7) positioned at at least one end of the connecting piece, the thread configured such that at least one of the first and second elements can be connected to the connecting piece by a threaded connection; and

- at least one gripping element (2) disposed around the outer surface of the connecting piece manipulatable for allowing either the connecting piece to rotate relative to at least one of the first and second elements or at least one of the first and second elements to rotate relative to the connecting piece while making a threaded connection, the gripping element comprising:

- at least two straight portions (see straight portions of 2) arranged such that two straight portions on opposite sides of the connecting piece are parallel, the straight portions forming gripping surfaces for a tool;



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the gripping element formed of two or more ribs disposed circumferentially around the connecting piece (1, 2);

whereby the gripping element is formed such that a tool surrounding the gripping element slips before the thread of the connecting piece gets damaged.

With regard to claim 7, and as seen in Figure 1, Hattori et al disclose the gripping element (2) comprising six straight portions.

With regard to claim 9 and as best understood by Examiner, Hattori et al disclose the portion which is arranged smooth being a rounded portion.

With regard to claim 12, and as seen in Figure 1, Hattori et al disclose a connecting piece, intended for connecting at least two elements, a first element connected to a first end of the connecting piece and a second element connected to a second end of the connecting piece, the connecting piece comprising:

a body (body of 1) mainly of thermoplast (column 3, lines 52-55);

a thread (7) positioned at at least one end of the connecting piece, the thread configured such that at least one of the first and second elements can be connected to the connecting piece by a threaded connection; and

at least one gripping element (2) disposed around the outer surface of the connecting piece manipulatable for allowing either the connecting piece to rotate relative to at least one of

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the first and second elements or at least one of the first and second elements to rotate relative to the connecting piece while making a threaded connection, the gripping element comprising:

at least two straight portions (see straight portions of 2) arranged such that two straight portions on opposite sides of the connecting piece are parallel, the straight portions forming gripping surfaces for a tool;

the gripping element formed of two or more ribs disposed circumferentially around the connecting piece (1, 2), each rib protruding outwards from the outer surface of the connecting piece;

whereby the gripping element is formed such that a tool surrounding the gripping element slips before the thread of the connecting piece gets damaged.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 2, 5, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egger EPO Patent No. EP 0 744 573 A1.

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With regard to claim 1, Egger discloses a connecting piece, intended for connecting at least two elements, a first element connected to a first end of the connecting piece and a second element connected to a second end of the connecting piece, the connecting piece comprising:

- a body (1);

- a metal insert (2) positioned at at least one end of the connecting piece, the metal insert provided with a thread, the metal insert configured such that at least one of the first and second elements can be connected to the connecting piece by a threaded connection; and

- at least one gripping element (elements next to and between 5) disposed around the outer surface of the connecting piece manipulatable for allowing either the connecting piece to rotate relative to at least one of the first and second elements or at least one of the first and second elements to rotate relative to the connecting piece while making a threaded connection, the gripping element comprising:

  - at least two straight portions (see Figure 2) arranged such that two straight portions on opposite sides of the connecting piece are parallel, the straight portions forming gripping surfaces for a tool;

  - the gripping element formed of two or more ribs disposed circumferentially around the connecting piece;

  - whereby the gripping element is formed such that a tool surrounding the gripping element slips before the thread and/or the basic structure of the connecting piece gets damaged.

However, Egger does not disclose that the body is mainly of plastic.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the body mainly of plastic because it has been held to be within the

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general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

With regard to claim 2, Egger discloses the gripping element comprising six straight portions (see Figure 2).

With regard to claim 5, and as best understood by Examiner, Egger discloses the portion which is arranged smooth being a rounded portion.

With regard to claim 11, and as seen in Figure 1, Egger discloses a connecting piece, intended for connecting at least two elements, a first element connected to a first end of the connecting piece and a second element connected to a second end of the connecting piece, the connecting piece comprising:

- a body (1);

- a metal insert (2) positioned at at least one end of the connecting piece, the metal insert provided with a thread, the metal insert configured such that at least one of the first and second elements can be connected to the connecting piece by a threaded connection; and

- at least one gripping element (elements next to and between 5) disposed around the outer surface of the connecting piece manipulatable for allowing either the connecting piece to rotate relative to at least one of the first and second elements or at least one of the first and second elements to rotate relative to the connecting piece while making a threaded connection, the gripping element comprising:

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at least two straight portions (see Figure 2) arranged such that two straight portions on opposite sides of the connecting piece are parallel, the straight portions forming gripping surfaces for a tool;

the gripping element formed of two or more ribs disposed circumferentially around the connecting piece, each rib forming a continuous ring around the outer surface of the connecting piece;

whereby the gripping element is formed such that a tool surrounding the gripping element slips before the thread and/or the basic structure of the connecting piece gets damaged.

However, Egger does not disclose that the body is mainly of plastic.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the body mainly of plastic because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

### ***Response to Arguments***

14. Applicant's arguments filed 4/29/09 have been fully considered but they are not persuasive.

a. Applicant argues that Mazzacano et al do not disclose a connecting pieces which comprises a gripping element formed of two more ribs disposed circumferentially around the connecting piece.

Examiner disagrees.

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Mazzacano et al disclose the connecting piece (102) comprising a gripping element (see Figure 1 above) formed of two or more ribs (ribs disposed around gripping element and connecting piece - next to 111).

15. Applicant's arguments with respect to claims 6, 7, 9, and 12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

16. Terry and Wise are being cited to show other examples of connecting pieces with gripping elements.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fannie Kee whose telephone number is (571) 272-1820. The examiner can normally be reached on 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron M Dunwoody/  
Primary Examiner, Art Unit 3679

/F. K./  
Examiner, Art Unit 3679  
June 16, 2009